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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,341	08/06/2003	Nisar A. Chaudhry	0720-4147	8082
27123	7590	05/17/2006	EXAMINER	
MORGAN & FINNEGAN, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101			BENENSON, BORIS	
			ART UNIT	PAPER NUMBER
			2836	

DATE MAILED: 05/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/635,341

Applicant(s)

CHAUDHRY, NISAR A.

Examiner

Boris Benenson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 1-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 10/29/2003.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

*Detailed Actions*

DETAILED ACTION

*Election/Restrictions*

1. Current application comprises and claims three different inventions.

I. Claims 1-8, drawn to a wiring error detection circuit, classified in class 361, subclass 42.

II. Claims 9-20, drawn to a power line surge protection device, classified in class 361, subclass 56/57.

III. Claims 21-34, drawn to a grounding module, classified in class 361, subclass 42.

The inventions are distinct, each from the other because of the following reasons:

a. Inventions III, and I, II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination III as claimed does not require the particulars of the subcombination I as claimed because the grounding module doesn't require specifics such as a first and

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second resistor, a transistor with collector connected to an AC neutral, and a zener diode connector in series with the AC line. The subcombination has separate utility such as a wiring error detection circuit.

b. Inventions III, and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination III as claimed does not require the particulars of the subcombination II as claimed because the grounding module doesn't require overcurrent protection, a data line surge protection and a switch for turning a surge suppression board on and off. The subcombination II has separate utility such as a power or data line surge protection device.

c. Inventions II, and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the

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instant case, the combination II as claimed does not require the particulars of the subcombination I as claimed because the power line surge protection device doesn't require specifics such as a first and second resistor, a transistor with collector connected to an AC neutral, and a zener diode connector in series with the AC line. The subcombination II has separate utility such as a power or data line surge protection device.

During a telephone conversation with attorney if the application Mr. James Hwa on 5/02/2006 a provisional election was made with traverse to prosecute the invention of a grounding module, claim 21-34. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-20 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

#### ***Claim Objections***

2. Claim 21 is objected to because of the following informalities: Claim language requires "a third conductor for connection to a ground" and "at least one external ground connection connected to the ground for providing the ground to an electrical device". Claim language doesn't indicate if "a ground" to which the third conductor is connected (presumably ground of an AC outlet) and "the ground" to which the external connection. Appropriate correction is required.

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3. Claims 33-34 are objected to because of the following informalities: the language of the Claims recites the limitation "illuminating the first LED". There is insufficient antecedent basis for this limitation in the claim.

Appropriate correction is required.

4. Claim 26 is objected to because of the following informalities: Claim 26 is dependent on Claim 25, that itself is dependent on Claim 21. Claims 21 and 25 didn't introduce a first and a second LED, therefore a term "a third LED" doesn't have sufficient antecedent basis. Appropriate correction is required.

5. Claim 31 is objected to because of the following informalities: Claim 31 is dependent on Claim 21, which doesn't indicate existence of a first, a second or a third LED, therefore a term a fourth LED doesn't have sufficient antecedent basis. Appropriate correction is required.

#### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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6. Claims 21-34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim requires "a wiring error detection circuit for providing the status of wiring of AC outlet when the AC plug is inserted to the AC outlet". According to the Specification the circuit (Figure 11) included an AC plug (1110) adapted to plug to an AC outlet, a female outlet (1160) and the wiring error detection circuit (1000) of Figure 10. The wiring error detection circuit (Fig.10, Pos. 1000) comprises an AC line (1001), an AC neutral line (1002) and ground (1003). A resistor (1005) and a diode (1010) connected in series in the AC line (1001). Is it intention of the Applicant to provide the female outlet with a pulsing power (due rectification by the diode 1010) with limited voltage (due voltage drop on 10 kilo-ohm resistor 1005)? Claims 22-34 do not provide any limitations, which could eliminate deficiency of Claim 21.

7. Claims 33-34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in

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the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 21 required "at least one external ground connection connected to the ground for providing the ground to the device". It appears that such external connection is shown on Figure 11, wherein "The module 1100 additionally includes an external ground connection in the form of a screw 1 170 and a passage 1 180 that communicates with the screw 1170 and receives external ground wires. The module 1100 also contains an additional ground connection in the form of a female F-type coaxial connector 1190" (Page 18), will always provide a ground potential to ground line (Fig.10, Pos. 1003). It is not clear how the presence or absence of an AC outlet's ground will control illumination of "the first LED by itself".

#### **Contact information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Boris Benenson whose telephone number is (571) 272-2048. The examiner can normally be reached on M-F (8:20-6:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Sircus can be



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reached on (571) 272-2800 ext 36. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Boris Benenson  
Examiner  
Art Unit 2836

B.B.



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